



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,661	10/30/2001	Thomas A. Wucherer	TRIRG-08851US0	4969

28554 7590 04/20/2005

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET, SUITE 540
SAN FRANCISCO, CA 94105

EXAMINER

RONES, CHARLES

ART UNIT PAPER NUMBER

2164

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,661

Applicant(s)

WUCHERER ET AL.

Examiner

Charles Rones

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

The amendment timely filed on January 5, 2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable by
Bonney et al. U.S. Patent No. 6,466,953 ('Bonney').

Bonney discloses :

As to claim 1,

adding a first graphical element to an image displayed on a monitor of a first
computer system; See 5:4-11;

displaying a graphical user interface on the monitor of the first computer system,
wherein the graphical user interface is configured for receiving non-graphical
information; See 5:20-45;

entering first non-graphical information into the graphical user interface wherein the entity name, device name, and description are deemed to be non-graphical entered into the graphical user interface; See 5:35-45; 6:7-13;

the first computer system transmitting first element data to a database for storage therein, wherein the first element data represents the first graphical element; See 5:55-65;

the first computer system transmitting first non-graphical information data to the database for storage therein, wherein the first non-graphical information data represents the first non-graphical information entered into the graphical user interface; See .

Bonney discloses the claimed invention except for storing data via the Internet communication. It would have been obvious to one having ordinary skill in the art at the time the invention was made to store data via an internet connection since it was known in the art that databases need not be located on a hard drive near the user, but can be on a network so other users can use the database and that connecting the database to the internet would allow anyone with access to the internet to gain access world-wide.

The modified invention of Bonney does not expressly show transmitting a component specification including at least one data element representing a physical or functional attribute, and at least one data element representing a non-physical and non-functional attribute or wherein the first component specification comprises a plurality of non-graphical information components, and wherein entering the component

Art Unit: 2164

specification into a graphical user interface comprises the plurality of non-graphical information components into the plurality of fields.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The transmitting and entering steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to maintain the stored dimension having a historically significant attribute in a first record; and storing the change to the dimension having a historically significant attribute in a second record system any type of data having any type of content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

MPEP 2106 IV B 1 (b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way in which computing processes are performed".

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)." (emphasis added)

The claim limitation language of “component specification comprising a plurality of fields and non-graphical information components and a data element representing a physical or functional attribute, at least one data element representing a non-physical and non-functional attribute” are deemed to be nonfunctional descriptive data (material).

Provided the data is found to be nonfunctional, a rejection can be made even if the prior art does not teach the exact content of data. This is because nonfunctional data is not processed by the computer or it does not alter the process steps, it only means something to the human mind. Common limitations where nonfunctional data *could be* found include those directed to sending, receiving storing and displaying data. Stated another way, according to the decision in *Lowry* mentioned above, prior court cases involving nonfunctional descriptive material “have no factual relevance if invention requires that information be processed by computer rather than the human mind.”

As to claim 2,

wherein the first computer system comprises a CAD computer system and wherein the first graphical element comprises a first CAD graphical element; See 5:1-65.

As to claim 3,

wherein the graphical user interface comprises a plurality of fields, wherein the first non-graphical information comprises a plurality of non-graphical information components, and wherein entering first non-graphical information into the graphical user interface comprises the plurality of non-graphical information components into the plurality of fields, respectively, of the graphical user interface; See 5:20-35.

As to claim 4,

the first computer system receiving, via internet communication, specification list data, wherein specification list data represents a list of specifications displayable on the monitor of the first computer system, wherein each specification of the list represents a data unit stored in the database in data communication with the first computer system, wherein each data unit contains data representing non-graphical information wherein specification data is deemed to be data that is stored in the database and is not giving any special patentability because of the type of data, data is deemed to include all data; See 5:4-65;

the first computer system displaying the list of specifications; See 5:5-65;

adding a second graphical element to the image displayed on the monitor of the first computer system; See 5:6-65;

the first computer system transmitting second graphical element data to the database for storage therein via internet communication, wherein the second graphical element data represents the second graphical element; See 5:6-65;

the first computer system transmitting link data to the database via internet communication, wherein the link data indicates that one of the data units stored in the database is to be linked within the database to the second graphical element data after the second graphical element data is stored in the database; See 5:6-65.

As to claim 18,

a database receiving and storing first CAD element data generated by a first computer system in data communication with the database, wherein the first CAD element data represents a first CAD element displayable on a monitor; See 5:6-65;

creating a link in the database between the stored first CAD element data and one of a plurality of component specifications stored in the database, wherein each of the plurality of component specifications comprises non-graphical descriptive data; See 5:6-65.

and the one of the plurality of component specifications stored in the database.

As to claims 5-17 and 19-26, they are combinations and subcombinations of limitation previously rejected and are rejected for their respective reasons as stated above.

Response to Arguments

Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Rones whose telephone number is 571-272-4085. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2164

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles Rones
Primary Examiner
Art Unit 2164

April 11, 2005